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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,108	11/12/2001	Jay S. Walker	97-051-C1	6408
22927	7590	12/19/2003	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			MYHRE, JAMES W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,108

Applicant(s)

WALKER ET AL.

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 27-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 12 of U.S. Patent No. 6,381,582. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the patent receives a code pertaining to an order submitted to a remote merchant, receives payment for the order at a local merchant, and transmits data indicating that payment has been received to the remote merchant, the present application receives order data pertaining to an order submitted to a remote merchant, receives payment for the order at a local merchant, and transmits data indicating that payment has been received to the remote merchant. Thus, the only difference is the receipt of a code (in the patent) vs the receipt of order data (in application), both pertaining to an order submitted to a remote merchant. However,

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neither the code nor the order data has been limited to exclude each other. Thus, the order data could include a code, such as an order number. Likewise, the code could include order data, such as the price. Similarly, Claim 12 of the patent and Claim 29 of the present application both add the feature that the local merchant is a third party.

Drawings

3. New corrected drawings are required in this application because Figure 2-C has been mislabeled as Figure 5-C as was discussed in the patent application. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kravitz(6,029,150).

Claim 27: Kravitz discloses a method for processing payment for a sale of goods in which a remote merchant receives an order from a customer, the customer arranges payment for the order with his local agent, the remote merchant receives notification of

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the payment receipt, and the goods are then shipped to the customer (col 7, line 12 – col 10, line 60). While Kravitz does not disclose that the local agent is a local seller (i.e. another merchant), the present claims do not include any transaction being completed with the local seller, thus, little patentable weight is given to the other fields of endeavor in which the payment receiver may be engaged. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the agent could also be a merchant. One would have been motivated to use a local merchant as the agent in Kravitz in order to have a ready-made extensive network of agents, thus eliminating the need to set up an additional system of agents throughout the country.

Claim 28: Kravitz discloses a method for processing a payment for a sale of goods as in Claim 27 above, and further discloses that the order data includes at least the price of the order (col 7, line 12 – col 10, line 60).

Claim 29: Kravitz discloses a method for processing a payment for a sale of goods as in Claim 27 above, and further discloses that the local seller (agent) is a third party (col 7, line 12 – col 10, line 60). While it is not explicitly disclosed that the agent and the remote merchant have a contractual relationship, since the merchant must trust that the agent's certificate of payment it is inherent that the two entities have an agreement to participate in the system disclosed by Kravitz. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to solidify such an agreement through the use of a contract. One would have been motivated to have a contractual relationship between the parties involved in the

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transaction and payment in order to have set guidelines, security measures (e.g. encryption), and verification procedures.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Colley et al (5,616,902) discloses a bill paying system and method in which the customer enters the bills into a kiosk along with the payment. The kiosk then transmits notification of payment received to the appropriate remote merchant.

b. Rosen (5,671,280) discloses a system and method for using trusted agents for paying remote merchants.

c. Teper et al (5,815,665) discloses a system and method for using trusted brokers to anonymously conduct online purchases.

d. Daly et al (5,878,141) discloses a system and method for conducting remote transactions online using a third party to effectuate payments.

e. Cordery et al(6,134,328) discloses a system for conducting electronic commerce with remote merchants using a third party certificate to verify payment.

f. Herman et al (6,341,353) discloses a system for using a trusted agent to issue a "Smart Receipt" during a remote transaction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

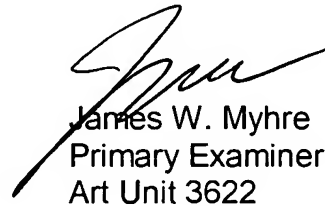
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



December 12, 2003



James W. Myhre
Primary Examiner
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